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09/577,551	05/24/2000	Wayne K. Dunshee	53481USA1B	5353

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Office of Intellectual Property Counsel
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/577,551
Filing Date: May 24, 2000
Appellant(s): DUNSHEE ET AL.

Ann Muetting
For Appellant

**SUPPLEMENTAL
EXAMINER'S ANSWER**

MAILED
DEC 19 2003

This is in response to the appeal brief filed 12/23/02 and the "Order Returning Undocketed Appeal to Examiner" of 8/25/03. This Supplemental Examiner's Answer corrects the claims that are rejected according to the "Order Returning Undocketed Appeal to Examiner" of 8/25/03 and the amendments which are pending in the instant application. Note the correction to the claims noted in paragraph 10 Grounds of Rejection below.

1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant states that the claims stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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4,334,530

HASSELL

6-1982

EP 596503 A1 MIYAMOTO et al. 5-1994

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

I. Claims 11-13, 16-33, 35-37, 39-45 and 49-52 are rejected under 35

U.S.C. 103(a) as being unpatentable over US Pat. No. 5162141 Davey et al. in view of US Pat. No. 4334530 Hassell and EP 596503 Miyamoto et al..

Davey et al. discloses a method falling within the scope of the instant claims 11, 13, 16-21, 23, 24, 25-27, 30-33, and 39-43 at the abstract; column 3, lines 19-42 and 58-65, many of these polymers contain elastomeric properties necessarily: column 4, lines 1-68; column 5, lines 1-31; column 6, lines 50-68, in which the polyurethane primer layer of Permuthane UE-40-570 is expected to necessarily possess a molecular weight within the broad range of the instant claims in order to function properly based on viscosity (definition of viscosity average molecular weight) and physical property (polymer texts relate physical properties to molecular weight) considerations. Since the image of the instant claims is not specified, the polyurethane printed onto the elastomer of the patentee falls within the scope of the instantly claimed "image". The instant claims recite "comprising" and therefore encompass other layers of printing. Davey is not limited to flooring nor rigid substrates as argued by the appellant. Davey clearly specifies polymeric sheet generically, including sheets of polymers which are necessarily elastomeric. This clearly translates to coating bandages, as stated below. Besides, if it works on flooring, it would have been expected to work exceptionally on a

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bandage since the bandage does not get nearly the stresses and strains as flooring. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to coat a bandage with an image according to the instant claims because it is known to coat bandages with images as shown by Hassell, the color of the image is only a matter of preference, and the use of the instantly claimed primers and overcoats would have been expected to give the results stated by Davey et al. and Miyamoto et al.. It is noted that primer and overcoat would have been expected to contribute to abrasion resistance because primer adheres the layer more firmly by definition making it harder to scrape off and overcoat gives another layer that must be scraped off, each necessarily requiring more energy to scrape off resulting in abrasion resistance over the ink image not containing these layers.

(11) Response to Argument

I. This argument relates to the above paragraph 10 I and the appellant's arguments thereto. The applicant argues that Hassel, Davey, and Miyamoto et al. are not analogous art. This is untrue as they all relate to coating polymeric elastomeric films with inks. At the very least, MPEP 2141.01(a), as follows applies: Analogous and Nonanalogous Art

TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE
ANALOGOUS PRIOR ART

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The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). Certainly coating polymeric films with inks links all three references as analogous art or at the very least meets the underlined portions of the MPEP cited above. As stated in the final rejection, if the inks of Davey and Miyamoto function in the described process so well, they will necessarily function excellently in printing bandages by the same method since bandages are not subjected to the harsh stresses of the

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films of Davey and Miyamoto. The permanence of the bond of Davey's substrate, noted by the appellant in their brief at page 6, is clearly desired in bandages of Hassel. One does not want little children licking the Mickey Mouse images off of their bandages. It is unclear how the teachings of Davey and Miyamoto are not pertinent to the problems encountered in applying ink to elastomeric bandages as all apply ink to elastomeric films. The appellant argues that Davey relates only to floor coverings. This is not true, as stated above. Davey relates to polymeric sheets generically and many of the disclosed polymers are necessarily elastomeric. See column 2, line 36. The appellant has not shown otherwise. The appellant has not shown the types of stresses and strains to be significantly different either nor that the types of stresses and strains contribute any unexpected results to the above discussed coating methods. Contrary to the appellant's assertion that flooring remains in a fixed place, buildings are known to expand and contract with geographical forces and with heat expansion and cold contraction. This stretches the flooring as does the motion of people walking on it. The appellant's assertion that the polymers of Davey are not necessarily elastomeric lacks probative evidence. It is noted that many of the disclosed polymers are always elastomeric and the appellant has not provided evidence to the contrary


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though asked for it in the interview of 8/5/02. Miyamoto further relates to bandages as similar stresses are placed on bandages when they are sterilized.

The appellant's argument that impermissible hindsight is used in the above rejection is not true as the proper motivation to combine the references is given clearly, particularly since all relate to printing ink on elastomeric polymeric films.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Patrick Niland
Primary Examiner
Art Unit 1714

pn

December 16, 2003

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